

10/676,706

DOCKET NO.: P1845R1C2

REMARKS

At the time of the 6/15/04 Office Action, claims 1-10 and 17 were pending in the instant application.

Restriction Requirement

The Examiner has maintained the restriction requirement asserting that the compounds of formula II represent such structural diversity that it would require an undue burden to search. Applicants respectfully disagree for the reasons stated in the previous amendment/response dated 14 May 2004.

"If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP 803. Compounds of the invention all have a structural similarity or common core as defined by formula II in that they all incorporate a fluorenyl ring linked to a phenylalanine analog residue and possess a common utility as inhibitors of alpha-4 integrins. Applicants in their 14 May 2004 response amended the definition of R9 such that the claims do not encompass compounds claimed in parent application that has issued as US patent no. 6,706,753 in which R8 and R9 together form a ring. The instant claims are otherwise commensurate in scope to those in the '753 patent.

However, the Examiner in the instant action has removed from consideration compounds of formula (II) in which R1, R3 and R4 include a "heterocycle" and R9 includes "an amino acid residue". The Examiner did not find it an undue burden when granting the '753 patent to search compounds of formula (II) with these very same groups, therefore the Applicants fail to understand why there is an undue burden in the instant application. Under the Examiner's restriction, in order to attain a claim scope commensurate in scope with the '753 patent Applicants would have to file numerous applications. For example, to claim all the permutations and combinations created by the restriction, Applicants would need file one application to claim compounds in which R1 is a heterocycle while R3 and R4 are other than heterocycle; another application to claim compounds in which R3 is a heterocycle while R1 and R4 are other heterocycle; and so on. Applicants respectfully request the Examiner reconsider the restriction requirement and prosecute the claims in their current form which is commensurate in scope with US 6,706,753.

10/676,706

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Double Patenting Rejection

Claims 1-10 and 17 stand rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1-10 in US Patent no. 6,706,753. Applicants herewith file a terminal disclaimer in accordance with 37 CFR 1,321(c) thereby obviating the rejection.

Rejections under 35 USC 112

Claims 1-10 and 17 stand rejected under the 2nd paragraph of 35 USC 112 as being indefinite. Specifically, the Examiner asserts that the phrase "amino acid residue" in the definition of R9 is unclear and open ended because it can be "any of 20 essential or non-essential amino acids". Applicants fail to understand how this phrase which is well established in the art can be considered indefinite or open ended as it is used in its current context. The USPTO routinely issues claims incorporating this phrase. Indeed, the present Examiner issued such claims in US patent 6,706,753 to which the instant application claims priority.

In view of the remarks presented above, the claims are believed to be in condition for allowance and notice thereof is respectfully requested.

Respectfully submitted,

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* A copy of a document pursuant to 37 C.F.R. §101.9(b) is attached as proof of the authorization of the above to prosecute the attached application. The original of this document is on file in the Office of enrollment and Discipline.